



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/527,632

10/06/2005

Ronald Forbes

63070(50024)

7115

21874

7590

05/21/2008

EDWARDS ANGELL PALMER & DODGE LLP

P.O. BOX 55874

BOSTON, MA 02205

EXAMINER

GOLDMAN, MICHAEL H

ART UNIT

PAPER NUMBER

3688

MAIL DATE

DELIVERY MODE

05/21/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/527,632	<b>Applicant(s)</b> FORBES, RONALD	
	<b>Examiner</b> MICHAEL H. GOLDMAN	<b>Art Unit</b> 3688	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 06 October 2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-26 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 March 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>4-10-06</u>   | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

1. The following non-final, first action on the merits is in response to the initial filing on October 6, 2005. Claims 1-26 are pending and have been considered below.

### ***Specification***

2. The following guidelines illustrate the preferred layout for the specification of a utility application. These guidelines are suggested for the applicant's use.

#### **Arrangement of the Specification**

As provided in 37 CFR 1.77(b), the specification of a utility application should include the following sections in order. Each of the lettered items should appear in upper case, without underlining or bold type, as a section heading. If no text follows the section heading, the phrase "Not Applicable" should follow the section heading:

- (a) TITLE OF THE INVENTION.
- (b) CROSS-REFERENCE TO RELATED APPLICATIONS.
- (c) STATEMENT REGARDING FEDERALLY SPONSORED RESEARCH OR DEVELOPMENT.
- (d) THE NAMES OF THE PARTIES TO A JOINT RESEARCH AGREEMENT.
- (e) INCORPORATION-BY-REFERENCE OF MATERIAL SUBMITTED ON A COMPACT DISC.
- (f) BACKGROUND OF THE INVENTION.
  - (1) Field of the Invention.
  - (2) Description of Related Art including information disclosed under 37 CFR 1.97 and 1.98.
- (g) BRIEF SUMMARY OF THE INVENTION.
- (h) BRIEF DESCRIPTION OF THE SEVERAL VIEWS OF THE DRAWING(S).
- (i) DETAILED DESCRIPTION OF THE INVENTION.
- (j) CLAIM OR CLAIMS (commencing on a separate sheet).
- (k) ABSTRACT OF THE DISCLOSURE (commencing on a separate sheet).
- (l) SEQUENCE LISTING (See MPEP § 2424 and 37 CFR 1.821-1.825. A "Sequence Listing" is required on paper if the application discloses a nucleotide or amino acid sequence as defined in 37 CFR 1.821(a) and if the required "Sequence Listing" is not submitted as an electronic document on compact disc).

In the instant application, the cross-reference to related applications is missing from the first page of the specification (see (b) above).

### ***Claim Objections***

3. Claims 6, 7, 9, 10 and 11 are objected to under 37 CFR 1.75(c) as being in improper form because of a reference to a preceding multiple dependent claim (i.e. claim 4). See MPEP § 608.01(n). Accordingly, claims 6, 7, 9, 10 and 12 will only be treated on the merits of the first of each of the multiple claims recited.

### ***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 26 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite in that it fails to point out what is included or excluded by the claim language. This claim is an omnibus type claim. (E.g. the specification page 21, lines 28-29 recites 'the carrier may be any entity or device capable of carrying the program'.)

### ***Claim Rejections - 35 USC § 101***

5. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 25 and 26 are directed to non-statutory subject matter, see MPEP 2107.01, Inventions patentable.

Claim 25 is directed to a computer software program,. The Office considers a computer program to be non-statutory functional data per se when it is not explicitly recited as being on a computer readable medium. In order to overcome this rejection the Applicant may amend the claim as that it becomes a product claim directed to the computer readable medium, such as "A computer readable medium having a computer program stored thereon which when executed by a computer performs a series of steps, comprising:"

Claim 26 is directed to a carrier. The specification defines a "carrier" as "any entity or device capable of carrying the program". The Examiner notes that this would also include paper with the executable program printed thereon. Thus, the scope of the claim, given its broadest possible interpretation, would also encompass non-statutory printed matter per se.

#### **EXAMINER'S NOTE**

6. It appears the Applicant is attempting to invoke 35 U.S.C. 112, 6<sup>th</sup> paragraph in Claims 1, 4, 5, 10 and 12 by using "means-plus-function" language, such as "means for generating", "means for transmitting", "means for encoding", etc. in the above claims. In order to successfully invoke the sixth paragraph, a three-prong test must be met. Namely, (1) the claim must use means-plus-function language; (2) the claim itself must not provide structural limitations to the means-plus-function language; and (3) the

Art Unit: 3688

specification must recite explicit physical structural limitations for the means-plus-function language in the claim. Page 10, lines 26 through page 12, line 25, and Figure 3 provides an 'Exemplary Apparatus' as one example of implementing the 'means for' functions such as a message processor (106), a message optimizer (116) and a mobile device (124). Therefore, 35 U.S.C 112, 6<sup>th</sup> paragraph has been successfully invoked.

***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8. Claims 1, 2, 7, 8, 9, 13, 14, 19, 20, 25 and 26 rejected under 35 U.S.C. 102(e) as being anticipated by Petrovich (7155405).

Claim 1 and 13: Petrovich discloses a system and method comprising:

a database for storing the capabilities of and identifying mobile devices (see column 16, lines 45-50 whereby personally owned compatible m-commerce devices may be utilized with the disclosed system, the database 1000 may include an association of unique device IDs of a plurality of portable devices with the names of device owners, examiner construes database 1000 as storing the capabilities of mobile devices);

a mobile device (see FIG 1, item 102, mobile device);

a message processor generating message data comprising a coupon (see column 22, lines 35-37 whereby the m-commerce device receiving an electronic coupon in response to the dataform being read, examiner construes mobile device (m-commerce device) receiving coupon from the system as message processor generating message data comprising a coupon, also see FIG 1, item 124, local m-com server (processor) and FIG 2, item 216 'system (generates) transmits data to portable device');

a message optimizer responsive to message data and stored capabilities to mobile device (see column 16, lines 45-50 whereby personally owned compatible m-commerce devices may be utilized with the disclosed system, the database 1000 may include an association of unique device IDs of a plurality of portable devices with the names of device owners, examiner construes an association of unique device IDs as message optimizer responsive to capabilities corresponding to mobile device via type identifier, message data and stored data of mobile device); and

communication means for transmitting optimized message to mobile device (see FIG 1).

Claim 2 and 14: Petrovich discloses the invention as in claim 1 and 13 above, and further discloses a system characterized in that capabilities comprise at least one device attribute associated with a mobile device (see column 17, lines 24-28).

Claim 7, 8, 19 and 20: Petrovich discloses the invention as in claim 1 and 13 above, and further discloses a system characterized in that capabilities comprise multimedia content including video, audio or a photograph (see column 18, line 7 'multimedia advertising', also see column 20, line 1 'images, audio and video files').

Claim 9: Petrovich discloses the invention as in claim 1 above, and further discloses a system characterized in that message data further comprises mobile device type identifier (see column 1, lines 40-43 whereby marketing messages can be sent directly to the customer via his or her m-commerce device based upon their locations or other triggers, examiner construes message data as inherently comprising mobile device type identifier).

Claim 25 and 26: Petrovich discloses the invention as in claim 13 above, and further discloses a system characterized in that a computer program carries out the method via a carrier (see FIG 1, item 108 network wireless carrier and FIG 2, Program).

### ***Claim Rejections - 35 USC § 103***

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.



The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

10. Claims 3, 4, 15, and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Petrovich (7155405) in view of Lundy (7305442).

Claim 3 and 15: Petrovich discloses the invention in claim 2 and 13 above, however fails to disclose a system characterized in that capabilities of mobile device comprising a display dimension and/or color depth.

Lundy discloses the feature whereby a system characterization of capabilities of a mobile device comprise a color depth (see column 1, lines 33-34 'a computer or wireless terminal may receive the advertisement, also see column 6, lines 19-21 whereby the display may include color graphics (color depth)).

Both Lundy and Petrovich disclose a system whereby display advertising may be provided to wireless terminals (mobile devices). Therefore, it would have been obvious for one skilled in the art at the time of the invention to modify the invention of Petrovich to include the features of color depth in the mobile device display in order to provide more effective attention getting advertisements, thereby increasing the number of transactions.

Claim 4 and 16: Petrovich discloses the invention in claim 1 and 13 above, however fails to disclose a system characterized in that said communications means comprises a gateway means,.

Lundy discloses the feature whereby the communications system comprises a gateway means (see column 3, lines 48-49).

Both Lundy and Petrovich disclose a system whereby display advertising may be provided to wireless terminals (mobile devices) via a communications network. Therefore, it would have been obvious for one skilled in the art at the time of the invention to modify the invention of Petrovich to include the feature whereby a subscriber is coupled by a gateway to the communications network in order to provide connectivity to a broad spectrum of mobile users.

11. Claims 5 and 17 rejected under 35 U.S.C. 103(a) as being unpatentable over Petrovich (7155405) in view of Lundy (7305442) and further in view of Mankoff (6868426).

Claim 5 and 17: Petrovich and Lundy discloses the invention in claim 4 and 13 above, however fails to disclose the feature of a system characterized in that said communications means comprises a router.

Mankoff discloses wherein the feature of a communications network is provided along with a router (see column 5, line 64).

Both Petrovich and Lundy, and Mankoff disclose a system and method for managing display information on a network connected user database. Therefore, it would have been obvious for one skilled in the art at the time of the invention to modify the invention of Petrovich to include the feature whereby a router is provided along with the communications network in order to effectively and efficiently provide connectivity to a broad spectrum of mobile users.

12. Claims 6, 10, 11, 12, 18, 21-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Petrovich (7155405).

Claim 6, 10, 11, 12, 18, 22, 23 and 24: Petrovich discloses the invention as in claim 2 and 13 above, however fails to disclose a system characterized in that said coupon comprises a barcode number, barcode symbology, a barcode image, text content, a barcode generator, means for generating barcodes, random barcodes, barcode encoder, and encoding said generated barcodes. (E.g. see XU et al. (7028902) abstract, lines 1-14 and column 9, lines 33-37).

However, Examiner takes Official Notice that barcodes and bar coding are old and well known in the art. Therefore, it would have been obvious for a person having ordinary skill in the art at the time of the invention to modify the invention of Petrovich to use these old and well known resources. One would have been motivated to do so in order to provide for effective, efficient and secure means for providing coupons to customers.

Claim 21: : Petrovich discloses the invention as in claim 13 above, however fails to disclose a system characterized in that step of generating the optimized messages comprises downgrading said generated message.

However, it would have been obvious for a person having ordinary skill in the art at the time of the invention to modify the invention of Petrovich to include downgrading. One would have been motivated to do so in order to match messages transmitted with the capabilities of the mobile devices to preclude the customer from technical difficulties with their equipment.

### ***Conclusion***

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Xu (7028902) discloses a system and method of barcodes having enhanced visual quality and systems and method thereof.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MICHAEL H. GOLDMAN whose telephone number is (571)270-5101. The examiner can normally be reached on Monday thru Thursday 6:00am-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on 571-272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3688

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

mhg  
May 19, 2008

/James W Myhre/  
Primary Examiner, Art Unit 3688